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MS APPEAL BRIEF - PATENTS  
PATENT  
3273-0142P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

Hiroaki ARITA

Appeal No.:

Appl. No.: 09/869,425

Group: 1711

Filed: June 27, 2001

Examiner: U. RAJGURU

Conf.: 3973

For: RESIN COMPOSITION HAVING IMPROVED IMPACT  
RESISTANCE AT LOW TEMPERATURES

APPEAL BRIEF TRANSMITTAL FORM

**MS APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

June 11, 2003

Sir:

Transmitted herewith is an Appeal Brief (in triplicate) on behalf of the Appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

A Notice of Appeal was filed on April 11, 2003.

☐ Applicant claims small entity status in accordance with 37 C.F.R. § 1.27

The fee has been calculated as shown below:

☐ Extension of time fee pursuant to 37 C.F.R. §§ 1.17 and 1.136(a) -

☒ Fee for filing an Appeal Brief - \$320.00 (large entity).

☒ Check(s) in the amount of \$320.00 is(are) attached.

Appl. No. 09/869,425

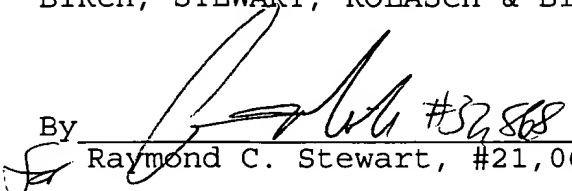
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Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

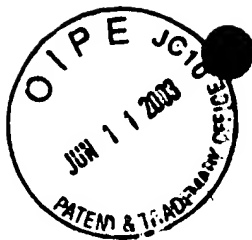
 #32868  
Raymond C. Stewart, #21,066

  
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3273-0142P

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Attachment(s)

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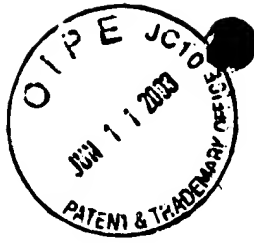
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## APPEAL BRIEF

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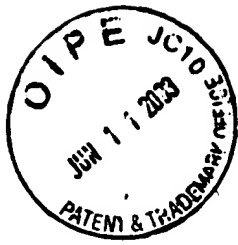
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of  
Hiroaki ARITA

Before the Board of Appeals  
Appeal No.:

Appl. No.: 09/869,425

Group: 1711 #13

Filed: June 27, 2001

Examiner: U. RAJGURU

Conf. No.: 3973

For: RESIN COMPOSITION HAVING IMPROVED IMPACT RESISTANCE  
AT LOW TEMPERATURES

**BRIEF ON APPEAL**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

June 11, 2003

Sir:

This is an appeal from the Final Rejection that was mailed on October 24  
2002.

***(1) Real party in interest.***

The real party in interest in this appeal is the Assignee, DAICEL-HÜLS  
LTD. of Tokyo, Japan.

***(2) Related appeals and interferences.***

There are no related appeals or interferences.

***(3) Status of claims.***

Claims 1-6, which are all of the claims in the case, stand rejected.

***(4) Status of Amendments.***

In an Advisory Action mailed on March 14, 2003, the Examiner kindly indicated that the 'Amendment under 37 CFR 1.116' which was filed on January 24, 2003 would be entered for purposes of appeal.

***(5) Summary of invention.***

The present invention provides resin compositions that have improved low temperature impact resistance, without sacrificing their tensile properties, flexural properties, and heat resistance properties. Specification, page 2, lines 10-14. More specifically, the present invention incorporates a glycol or glycol derivative into a thermoplastic elastomer to provide a resin composition that can be used to make a molded article having good tensile properties, good flexural properties, good heat resistance properties, and good impact resistance even at low temperatures. Specification, page 2, lines 16-24. See also

Examples 1 and 2 and Table 1 on page 12 of the specification, where specific compositions of the invention were molded, tested, and found to have good tensile strength, good tensile elongation, good flexural strength, good elastic modulus in bending, and good IZOD impact strength, all at room temperature, and additionally to have good IZOD impact strength at -20°C.

**(6) Issues.**

The sole issue in this appeal is whether claims 1-6 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over US 4,956,423 (Lee).

**(7) Grouping of claims.**

For the purpose of this appeal, the inventions of claims 5 and 6 are considered to be not *prima facie* obvious for all of the reasons applicable to claims 1-4 and for separate additional reasons.

**(8) Argument.**

Claims 1-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US 4,956,423 (Lee). The rejection as stated is respectfully traversed.

The Examiner acknowledges that the Lee reference fails to mention glycol or its derivatives. The Examiner speculates, however, that a polyetheramide

might contain "some amount of glycol in it as an unreacted material". Final Rejection, page 2. The Examiner elaborates:

Though Lee does not specify any amount of glycol, it is reasonable to expect that the glycol component can be present in the composition, as an unreacted material at as low as (claimed) 0.1. Lee teaches glycol in claimed amount. Claims 1-6 are therefore *prima facie* obvious.

Advisory Action of 03/14/2003, page 2.

The rejection as stated lacks internal logic. If -- as the Examiner contends -- "Lee teaches glycol in claimed amount" -- Lee anticipates the present claims, and a rejection under 35 U.S.C. §102(b) should be lodged against the claims.

Also, however, Applicants respectfully urge that this speculative opinion of the Examiner does not provide statutory basis for a proper *prima facie* obviousness rejection. The claims herein recite precise relative amounts of glycol in the claimed compositions. There is no evidence of record -- apart from the Examiner's use of the phrase "reasonable to expect" -- that Lee teaches or suggests compositions containing from 0.1 to 10 parts by weight, relative to 100 parts by weight of an elastomer, of a glycol or its derivative.

As noted above, one object of the resin composition of the present invention, which is designed to be used in the manufacture of molded articles, is to substantially improve impact resistance at low temperatures, while at the



same time maintaining good tensile properties, flexural properties, and heat resistance properties. In contrast, Lee's object is to provide a hot melt adhesive having a high adhesive strength and good oil resistance. The claimed invention and the technology described by Lee are completely different from one another in object and use. Clearly, Lee fails to teach or suggest the significance and effect of including a specific amount of glycol or its derivatives in thermoplastic elastomer compositions. The present invention is not **obvious** from Lee.

Attention is respectfully directed to the decision of the Court of Appeals for the Federal Circuit in *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000). In that case, the claims were rejected over different items selected from within a single reference. The CAFC said that the PTO had fallen into "the hindsight trap" and located within the reference statements that **conjecturally could be put together** to suggest the claimed invention. But the court found that there was no finding by the PTO as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed, and that thus the PTO had not made out a proper *prima facie* case of obviousness. Here, the claims are **conjecturally** rejected over different items one of which is not even mentioned by the reference! This is manifestly improper under the law of obviousness as it is construed in *Kotzab*.

The Examiner's reasoning might be relevant if the Examiner were rejecting the claims under 35 U.S.C. §102. However, it is respectfully submitted that the Examiner's rationale for the rejection of record, which is made under 35 U.S.C. §103(a), is clearly improper.

Claim 5 requires a minimum of 0.5 parts by weight of glycol relative to 100 parts by weight of the thermoplastic elastomer. The Examiner has not explained how this quantitative limitation is met by the reference.

Claim 6 is drawn to a molded article. The Examiner has not explained how Lee's disclosure of hot melt adhesives suggests molded articles.

#### Conclusion

The rejections of record cannot logically be sustained.

If there are any questions concerning this application, please contact Richard Gallagher, Reg. No. 28,781, at (703) 205-8008.

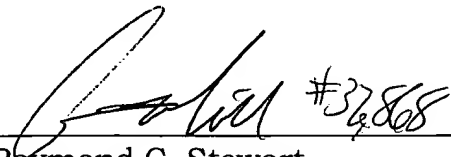
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Respectfully submitted,

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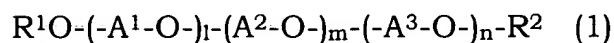
**(9) Appendix.**

1. A resin composition comprising a polyamide-based thermoplastic elastomer and from 0.1 to 10 parts by weight, relative to 100 parts by weight of the elastomer, of a glycol or its derivative.

2. A resin composition comprising a polyether amide block copolymer as a thermoplastic elastomer and from 0.1 to 10 parts by weight, relative to 100 parts by weight of the elastomer, of a glycol or its derivative.

3. The resin composition according to claim 1, wherein said thermoplastic elastomer has a soft segment composed of a polyether or polyester.

4. The resin composition according to claim 1 or 2, wherein said glycol or its derivative is a compound represented by the following Formula (1):



wherein each of  $R^1$  and  $R^2$  is, identical to or different from each other, a hydrogen atom, an alkyl group, or an acyl group; each of  $A^1$ ,  $A^2$  and  $A^3$  is, identical to or different from one another, an alkylene group having 2 or more

carbon atoms; each of l, m and n is, identical to or different from one another, an integer of 0 or more, where  $l+m+n>0$ .

5. The resin composition according to claim 1 or 2, wherein the amount of the glycol or its derivative is from about 0.5 to 6 parts by weight relative to 100 parts by weight of the thermoplastic elastomer.

6. A molded article composed of a resin composition according to claim 1 or 2